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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/736,998

**Applicant(s)**

BRESNAN ET AL.

**Examiner**

ROB WU

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-76 of copending Application No. 10/737244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed limitations are being claimed in separate claims that would have been obvious to combine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 24-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claim 24 recites a computer program and is considered functional descriptive material per se. A claim to a data structure per se or other functional descriptive material including computer program per se is not patent eligible subject matter. See *In Re Warmerdam* 31 USPO2d 1754

Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible results when used in the computer system.

6. Claims 52-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 52-57 are directed to a "method" and therefore are considered process claims for the purposes of § 101. To qualify as statutory subject matter, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70

Art Unit: 3628

(1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 52-57 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 13, 14, 34, 41, 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 5, 13, 14, 34, 41, 42 the phrase "may, or may not" renders the claim indefinite because it is unclear which limitation the applicant regards as the invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3628

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4, 9-12, 15-17, 30, 38-40, 43-45 are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Pat No. 5,058,030 to Schumacher.

**Referring to claim 1:**

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A customer relationship management system coupled to the consolidator module, the customer relationship management system determining at least some of the first criteria (col 10: lines 20-27)

**Referring to claim 2:**

The message processing system of claim 1 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages. (col 10: lines 31-40)

**Referring to claim 3:**

The message processing system of claim 2 wherein the template includes marketing content developed by marketing tools in the customer relationship management system. (col 10: lines 31-40)

**Referring to claim 4:**

The message processing system of claim 1 wherein the first criteria include marketing business rules determined by the customer relationship management system. (col 4: lines 15-21)

**Referring to claim 9:**

The message processing system of claim 1 wherein the consolidator module is coupled to a statement applications processing module, the statement applications processing module determining at least some of the first criteria. (col 11: lines 8-11)

**Referring to claim 10:**

The message processing system of claim 9 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages. (col 11: lines 8-11)

**Referring to claim 11:**

The message processing system of claim 9 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites. (col 11: lines 5-11)

**Referring to claim 12:**

The message processing system of claim 9 wherein the first criteria include sender rules received from the statement applications processing module. (col 11: lines 7-11)

**Referring to claim 15:**

The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the consolidator module forms in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 16:**

The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module form and route message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 17:**

The message processing system of claim 1 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address. (col 10: lines 31-40)

**Referring to claim 30:**

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)



Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

determining at least some of the first criteria through a customer relationship management system. (col 4: lines 9-21)

**Referring to claim 38:**

the method of claim 30 further including the step of determining at least some of the first criteria with a statement applications processing module. (col 11: lines 8-11)

**Referring to claim 39:**

the method of claim 38 further including the step of providing message business data from the statement applications processing module for forming the message packages. (col 11: lines 8-11)

**Referring to claim 40:**

The method of claim 38 wherein the step of determining at least some of the first includes incorporating sender rules received from the statement applications processing module. (col 10: lines 20-26)

**Referring to claim 43:**

The method of claim 40 wherein the sender rules include a requirement to maximize throughput of message packages, and the steps of consolidating is controlled to form message packages in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 44:**

Art Unit: 3628

The method of claim 40 wherein the sender rules include a requirement to minimize mail production costs, and the wherein the steps of consolidating is controlled to form message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 45:**

The method of claim 30 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address. (col 4: lines 35-40)

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5, 13, 14, 34, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of U.S. Pat No. 7,236,950 to Savage et al.

**Referring to claim 5:**

Schumacher does not expressly disclose that the message processing system of claim 4 wherein the marketing rules include a rule that message that include particular marketing content may, or may not, be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 13:**

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that message that include particular business content may, or may not, be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 14:**

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that message that include particular business content may, or may not, be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 34:**

Schumacher does not expressly disclose the method of claim 33 including a step of preventing messages from being consolidated based on the marketing rules that include a rule that message that include particular marketing content may, or may not, be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 41:**

Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 42:**

Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by householding contents.

15. Claims 6-8, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of U.S. Pub No. 2004/0230523 to Johnson.

**Referring to claim 6:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose that the message processing system of claim 1 wherein the first criteria include customer preferences.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly. [0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 7:**

Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 8:**

Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding

Art Unit: 3628

is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

**Referring to claim 35:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose gathering customer preference data and including it in the first criteria.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly. [0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 36:**

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so

to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 37:**

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which include a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

16. Claims 18-20, 22, 24-26, 28, 46-48, 50, 52-54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of U.S. Pub No. 2002/0133472 to Stepno.

**Referring to claim 18:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose that the message processing system of claim 17 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]



Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 19:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system of claim 18 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 20:**

Schumacher does not expressly disclose the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module is there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 22:**

Schumacher does not expressly disclose that the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 24:**

Schumacher discloses a message processing system for preparing a plurality of messages to be distributed to customers, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 25:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system of claim 24 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 26:**

Schumacher does not expressly disclose the message processing system of claim 24 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 28:**

Schumacher does not expressly disclose that the message processing system of claim 24 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 46:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose selecting messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific

Art Unit: 3628

motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 47:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 48:**

Schumacher does not expressly disclose determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and

Art Unit: 3628

therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 50:**

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 52:**

Schumacher discloses a method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

consolidating multiple of the plurality of messages into a single message package, said consolidating of the messages into consolidated message packages based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 53:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific



Art Unit: 3628

motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 54:**

Schumacher does not expressly disclose determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 56:**

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and

Art Unit: 3628

therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

17. Claims 21, 23, 27, 29, 49, 51, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Stepno in further view of Johnson.

**Referring to claims 21, 23, 27, 29, 49, 51, 55 and 57:**

Schumacher combined with Stepno disclose sending advertisements with the message to the recipient. (Schumacher col 4: lines 36-40) Schumacher combined with Stepno does not expressly disclose if the customer preference does not authorize consolidation or householding, the consolidator generates content to be included in the message that describes benefits of consolidation or householding.

Johnson disclose that sellers often offer discounts for quick payment. [0006] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to send an advertisement describing the advantages of message consolidation to the recipient, such as discounts offered.

18. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher.

**Referring to claim 31:**

Schumacher does not expressly disclose the method of claim 30 further comprising the step of determining a template for message packages with the customer relationship management system.

However, it would have been obvious at the time of the invention that a template for message packages is determined with the customer relationship management system. The template is determined such that the customer will receive consolidated mailing that is addressed to the customer.

**Referring to claim 32:**

Schumacher disclose the method of claim 31 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system. (col 4: lines 36-40)

**Referring to claim 33:**

Schumacher does not expressly disclose the method of claim 30 wherein the step of determining the first criteria includes marketing business rules determined by the customer relationship management system.

However, it would have been obvious at the time of the invention that marketing business rules are determined by the customer relationship management system, it is determined by Schumacher stating that publishers can send recipient advertisements. (col 4: lines 36-40)

***Conclusion***

Art Unit: 3628

19. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROB WU whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

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/R. W./

Examiner, Art Unit 3628

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628